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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/655,928   | 09/05/2003  | Bertold Gruetzmacher | 600.1243            | 8625             |
| 23280  | 7590        | 08/31/2006           | EXAMINER            |                  |
| DAVIDSON, DAVIDSON & KAPPEL, LLC<br>485 SEVENTH AVENUE, 14TH FLOOR<br>NEW YORK, NY 10018 |             |                      | WILLIAMS, KEVIN D   |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2854                |                  |

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/655,928

Applicant(s)

GRUETZMACHER ET AL.

Examiner

Kevin D. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/06/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. In view of the appeal brief filed on 6/2/2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Gross (US 6,649,266).

Gross teaches a microstructured carrier having a surface (Fig. 1; col. 1, lines 63-67), an ink repellent coating (col. 1, lines 65-67) on the surface of the microstructured carrier, the ink repellent coating including a derivative of an amphiphilic organic compound (col. 5, lines 48-53) having a polar region with an acidic character (col. 5, lines 15-17 and 45-50). Gross also teaches the microstructured carrier being metallic and having a natively oxidized surface, and the carrier having at least one substance selected from the group consisting of titanium, zirconium, molybdenum, nickel, copper, aluminum, chromium, iron, silver and gold (col. 3, lines 18-22).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wirz (US 5,479,856) in view of Gross (US 6,649,266) and further in view of Mohr (US 4,427,766).

Wirz teaches a printing press having print substrate-contacting element (col. 3, lines 50-52) comprising a carrier having a surface, an ink-repellent coating on the surface of the carrier, the print substrate-contacting element being a back-pressure cylinder or a part of a surface thereof.

Wirz does not teach the carrier being microstructured, the ink repellent coating including a derivative of an amphiphilic organic compound having a polar region with an acidic character, the derivative of an amphiphilic organic compound being a hydroxamic acid derivative or a phosphonic acid derivative, the carrier being metallic and having a natively oxidized surface, and the carrier having at least one substance selected from the group consisting of titanium, zirconium, molybdenum, nickel, copper, aluminum, chromium, iron, silver and gold.

Gross teaches that repellent properties can be increased by microstructuring a surface having a repellent coating and discloses a microstructured carrier having a ink repellent coating (Fig. 1; col. 1, lines 63-67). Gross discloses that this technique can be used on virtually any substance (col. 3, lines 13-15). Gross also teaches the microstructured carrier being metallic and having a natively oxidized surface, and the carrier having at least one substance selected from the group consisting of titanium, zirconium, molybdenum, nickel, copper, aluminum, chromium, iron, silver and gold (col. 3, lines 18-22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the carrier of Wirz to be a microstructured carrier as taught by Gross, in order to increase the effectiveness of its ink repellency.

Mohr teaches an ink repellent coating including a derivative of an amphiphilic organic compound having a polar region with an acidic character, the derivative of an amphiphilic organic compound being a hydroxamic acid derivative or a phosphonic acid derivative (col. 17, lines 17-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to additionally modify Wirz to have the phosphonic acid derivative as taught by Mohr, in order to improve the ink repellent qualities of the coating.

As described above in the 102 rejection, the examiner interprets the Gross reference to disclose an ink repellent coating including a derivative of an amphiphilic organic compound having a polar region with an acidic character. In an effort to expedite prosecution, the examiner has also added the immediately preceding rejection which utilizes a teaching of an ink repellent coating including a derivative of an amphiphilic organic compound having a polar region with an acidic character in Mohr.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wirz in view of Gross and Mohr as applied to claims 1-4, and 7-9 above, and further in view of Boardman (US 6,824,882).

Wirz in view of Gross and Mohr teaches the claimed invention except for the derivative of the amphiphilic organic compound being substituted in a nonpolar region so as to be both ink-repellent and water-repellent, and the derivative of the amphiphilic organic compound being fluorinated in a nonpolar region.

Boardman teaches a derivative of the amphiphilic organic compound being substituted in a nonpolar region so as to be both ink-repellent and water-repellent, and the derivative of the amphiphilic organic compound being fluorinated in a nonpolar region (col. 4, line 66 to col. 5, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to additionally modify Wirz to have the fluorinated phosphonic acid as taught

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by Boardman, in order to protect the print substrate contacting element by increasing the repellent action of the coating.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground of rejection.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin D. Williams whose telephone number is (571) 272-2172. The examiner can normally be reached on Monday - Friday, 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

KDW

August 21, 2006

A handwritten signature in black ink, appearing to read "Judy Nguyen", written in a cursive style.

**JUDY NGUYEN**  
**SUPERVISORY PATENT EXAMINER**